

REMARKS

A petition for a three (3) month extension of time is enclosed with this Response. Claims 24-39, 42, 44-47, 70-76, 78-82, 86, 91, 96-99 and 117 are currently pending. A listing of claims is not required since no claims have been amended herein. Reconsideration of the rejection under 35 USC § 112, first paragraph, is respectfully requested in view of the following remarks.

Once again, a completely new ground of rejection has been proffered by the Examiner in this case after the previous response overcame the previous ground of rejection. This pattern has repeated itself continuously over the course of prosecution of this application. The present outstanding Office Action is the **eleventh non-final** Office Action issued during the **six and one-half (6 ½) year pendency** of this case. Applicants' attorney is, quite frankly, extremely frustrated by the continuing series of unsustainable rejections that have been issued in piecemeal fashion in connection with this application.

As with the prior overcome rejection, the current rejection of claims 24-39, 42, 44-47, 70-76, 78-82, 86, 91, 96-99 and 117 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement, is baseless in fact and unsupportable at law.

In the present **twelfth** Office Action, it is just now asserted by the Examiner that the specification does not describe the addition of fluorescent pseudomonad or bacteria in general to the composition disclosed in the instant method. The Examiner admits that, "parts of the invention are clearly taught in the specification such as fluorescent pseudomonad having the ability to degrade essential oils and the application to soil, foliage, seeds and fruits a composition comprising an essential oil." The Examiner concludes by stating, "However, again the specification does not clearly describe the addition of fluorescent pseudomonad or bacteria in general to the composition disclosed in the instant method."

The Examiner is simply wrong. The specification, at page 9, lines 9-20, provides working examples that clearly refute the present rejection. As plainly stated therein:

All seeds were treated with a mixture of chitosan (80%) and essential oil from *Thymbra spicata* var. *spicata* (20 %) and planted in sterile soil. The bacterial treatment contained 1×10^6 CFU/mL *P. fluorescens* TR97 suspended in the chitosan/essential oil mixture.

Thus, a composition containing the claimed bacteria, essential oil and a suspending agent was made and tested as discussed with regard to Figures 8 and 9.

It is well-settled that, to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F. 3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2D 1111, 1116 (Fed.Cir. 1991). The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F. 2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”). The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims.

In view of the disclosure at page 9 of the specification, it is clear that the Examiner has not, and cannot, meet the burden of overcoming the presumption of adequate disclosure in the specification. Indeed, the one sentence relied on by the Examiner is an unsupported conclusion

which is incapable of meeting the Examiner's burden and legitimately supporting a rejection based on lack of adequate written description.

According to MPEP § 2163,

The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

The rejection by the Examiner constitutes a total failure to adhere to the examination guidelines established by the US Patent and Trademark Office. In view of the disclosure at page 9, there is simply no reasonable basis that was or could be presented to challenge the adequacy of the written description. The Examiner has failed to provide a single reason why a person skilled in the art would not recognize a description of the invention defined by the claims.

It is also well-settled that an application specification may show actual reduction to practice by describing testing of the claimed invention or, in the case of biological materials, by specifically describing a deposit made in accordance with 37 CFR 1.801 *et seq.* See *Enzo Biochem*, 323 F.3d 956, 965, 63 USPQ2d 1618, 1614 (Fed. Cir. 2002). A specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment or performed a process that met all the limitations of the claim and determined that the invention would work for its intended purpose. *Cooper v. Goldfarb*, 154 F. 3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998).

The description at page 9, including Figures 8 and 9, show an actual reduction to practice of the claimed invention. The working examples describe precisely what the Examiner erroneously contends is not present. Specific concentrations are provided for each ingredient

including the bacteria, chitosan and essential oil. At page 19 instructions are provided to produce emulsions. It is indisputable that manufacture of emulsions is well within the purview of a person of ordinary skill in the art. See, e.g., Remington's Pharmaceutical Sciences, 15th edition, Mack Publishing Company 1975, Chapt. 83 "Solutions, Emulsions and Suspensions", pp 1436 *et seq.*

It is also well-settled that:

What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F. 2d at 1384, 231 USPQ at 94. See also *Capon v. Eshhar*, 418 F. 3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005) ("The 'written description' requirement must be applied in the context of the particular invention and the state of the knowledge... As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution.") If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 f. 2D AT 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 f. 2D 746, 751, 172 USPQ2d 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

MPEP §2163.

Since the Examiner has failed to meet the burden of establishing a *prima facie* case of lack of written description by not providing any reasons why a person skilled in the art would not recognize an adequate written description of the claimed invention in the specification, and specification does, in fact, contain explicit working examples describing reduction to practice of the claimed invention, the rejection under 35 USC §112, first paragraph, should be reconsidered and withdrawn. Indeed, the rejection is unsupportable on the facts and the law.

A good faith effort has been made to place the present application in condition for allowance. If there is any point requiring consideration prior to allowance of this application, the Examiner is respectfully requested to telephone the undersigned attorney for applicants at the address indicated below.

Application No.: 09/807,254
Amendment dated January 24, 2008
Reply to Office Action of July 26, 2007

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jeffrey S. Steen', is written over a horizontal line.

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